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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/672,838 | 09/29/2000 | William Randolph Abernethy | 1497.1002 | 9563 |
| 21171 | 7590 | 10/27/2004 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | ZEENDER, FLORIAN M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3627 | |

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,838

Applicant(s)

ABERNETHY, WILLIAM
RANDOLPH

Examiner

F. Ryan Zeender

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 32 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 33-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claim 42 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The limitation "the interface showing a net asset value indicator indicating a net asset value reflecting information including changes made to the basket contents by asset issuer related events" has separate utility in the art and therefore the combination of all limitations in claim 42 is a separate distinct invention from what was originally presented in claims 1-41.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 42 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

Claims 1-31 and 33-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belzberg '535 in view of Stallaert et al. '287.

Belzberg '535 discloses, makes obvious, or inherently teaches routing a fungible goods trade order (*i.e.*, *stock trade order*) to an automated trade matching system (*i.e.*, *NASDAQ*) as a market matching order (See, for example, Col. 3, lines 20-32); the system further teaching basket trades (Col. 2, lines 29-32) using a single initiation action (*i.e.*, single key stroke; Col. 3, lines 51-67).

Belzberg '535 lacks the specific teaching of a weighting field allowing a user specified weighting, and limit pricing.

Stallaert et al. '287 teach a similar system and hardware configuration including: a weighting field (for example, step 203), and limit pricing.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Belzberg to include specified weighting and limit pricing, in view of Stallaert et al., in order to "squeeze out inefficiencies associated with the fragmented market" (See Stallaert et al., Col. 2, lines 18-20).

Re claims 6, 8-15, 19-29, 35-36, and 39-41: the limitations not clearly disclosed in Belzberg are limitations that are well known in asset trading, and to modify Belzberg to incorporate any of the limitations would have been an obvious design choice to one of ordinary skill in the art at the time of the invention to achieve a desired result.

Response to Arguments

Applicant's arguments filed 7/30/2004 have been fully considered but they are not persuasive.

Applicant argues on page 11, second paragraph, last two lines, of his response that his invention is "**not limited to selling/buying of stocks only when parameters specified by the user are met**". This limitation, however, is not found in the claims.

Applicant further argues on page 12, paragraph two, that the present invention provides a weighting field "**that is not limited to trading only when a surplus exists**". This limitation, however, is not found in the claims.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

All of the limitations, as presently written, are anticipated by the combination of prior art, whether viewed alone or in view of obvious design choices well known in the art. The applicant is directed to well known asset trading web sites such as E-trade and Scottrade for references teaching what is well known in the art.

With regards to other limitations argued by the applicant (for example limitations in claim 26 and 36), **the Applicant has failed to argue that the obvious design choice used by the Examiner is in some way inaccurate or incorrect.** Therefore, the rejections have been maintained.

The arguments with respect to newly submitted claim 42 are moot in view of the above withdrawal from consideration.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Ryan Zeender whose telephone number is (703) 308-8351. The examiner can normally be reached on Monday-Friday, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Olszewski can be reached on (703) 308-5183. The receptionist's phone number for the Technology center is (703) 308-1113.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9327 for after-final communications.

F. Zeender
Primary Examiner, A.U. 3627
October 25, 2004

 10/25/04
F. RYAN ZEENDER
PRIMARY EXAMINER